REMARKS

Reconsideration is respectfully requested.

Claims 19, 22 through 25, 33 through 39 and 55 through 66 remain in this application. Claims 1 through 18 and 26 through 32 have been cancelled. Claims 40 through 51 have been withdrawn. Claims 67 through 70 have been added.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraph 3 of the Office Action

Claims 19, 22 through 25, 33 through 39 and 55 through 66 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Ebisawa in view of Margulis.

In the "Response to Arguments" portion of the pending Office Action, it is stated that (emphasis in original):

> 4.   Applicant argues that in Ebisawa, the positions of the advertisements data elements on the screen is not changed or reposition relative to the source content. The Examiner disagrees with Applicant because as the user is playing a racing game, and " when *a* game program having the data structure shown in FIG. 3A is executed, commercial <u>advertisement</u> A is displayed in one scene of the auto racing program and <u>advertisement</u> C is displayed in another scene". As seen by Ebisawa above, as the scene (location) of the auto racing game changes so does the advertisements being displayed. Advertisements A is displayed on another scene different from the scene use to display advertisement C.

However, the discussion of displaying one advertisement in one scene and displaying a different advertisement in a different scene. It is submitted that this does not evidence to one of ordinary skill in the art the "updating [a] position of the virtual product location in the removable moving media through repositioning of the removable content relative to the source content" required by the claims, as there is nothing in the statement relied

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upon in the Response to Arguments" that indicates that there is any repositioning, or change in position. Claim 1, for example, requires "wherein the communication assembly allows the virtual product source to *update the position* of the virtual product location in the removable moving media *through repositioning* of the removable content relative to the source content". Again, as it has been noted before and below, the position of the advertisement shown in the drawings does not vary.

The "Response to Arguments" appears to take the position that displaying a first "Advertisement A" in one scene, and then displaying a second and different "Advertisement C" in another, different scene discloses updating a position by repositioning. It is submitted that one of ordinary skill in the art would not recognize that one advertisement displayed in one scene and a different advertisement displayed in a different scene discloses "repositioning" a product. Further, claim 19 refers to "updating *the* virtual product" by repositioning, and not "virtual products". Claim 68 further elaborates upon this distinction, and requires that "the position of the removable content in the source content is updated through repositioning without changing the virtual product in the virtual product location" (see the specification at the paragraph bridging pages 6 and 7 for discussion of this feature). Claim 66 includes similar language. This is submitted to be even more foreign to the operation of the system described in Ebisawa, which clearly requires the changing of the advertisement between scenes, even if the positions are not changed.

More specifically, claim 19 requires, in part, "a removable content disposed at a position within the *moving video images* of the source content for providing a virtual product location, *the virtual product location being movable within the video frame* of the source content as the moving video images are presented" and "wherein the communication assembly is configured to cause the virtual product source to place the virtual product within the source content of the removable moving media *at the position of*

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the removable content disposed within the video frame of the source content. Claim 33 has also been amended to require, in part, "an original moving media content source comprising moving video images presented within a video frame and including a removable content within the moving video images of the source content, the removable content providing a virtual product location at a position in the moving media, *the virtual product location being movable within the video frame of the source content as the moving video images are presented*" and "*wherein the position of the virtual product location relative to the moving media is updated by repositioning the virtual product location of the removable content relative to the video frame of the source content* as the moving video images of the source content are presented". Claims 55, 56 and 66 have been similarly but not identically amended.

It was alleged in the final rejection of the claims in the Office Action that (emphasis added):

> With respect to the newly amended feature of updating the position of the virtual product location in the removable moving media through repositioning of the removable content relative to the source content (i.e. In Figures 1A-1B, and Figures 2A-2B, <u>In order for advertisements A and C to be replaced with advertisements B and D, the location of advertisements A and C has to be changed in order for advertisements B and D to take it's place.</u> Therefore advertisements B and D's location is also updated or improved from a non-display location to a display location).

However, the allegation that "the location of A and C *has to be changed* in order for advertisements B and D to take it's place" appears to not be based upon what Ebisawa actually teaches, but instead appears to be based upon what the Patent Office believes *should* or *might* happen. As previously pointed out, and reiterated here, when one of ordinary skill in the art looks to the actual disclosure of the Ehisawa patent, particularly Figures 1A and IB, one of ordinary skill in the art sees that as the sequential advertisement data elements "A" and "B" in the Ebisawa system are interchanged, the position of the data elements does not change. More specifically, Ebisawa

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clearly shows in these drawings figures that the positions of the advertisement data elements on the screen in Figures 1A and IB is *identical*, and thus *is not changed* or "repositionfed]... *relative to the source content"* as required by the claims.

One can speculate that the position of the advertisement data elements "A" and "B" is changed in the Ebisawa system, but that is merely speculation of what one might believe "has to be", and not an actual teaching or disclosure of the Ebisawa patent.   Perhaps the Patent Office is relying upon an "inherent" teaching of the Ebisawa patent (which was not identified in the Office Action), but when the Ebisawa patent discloses the *position* of the advertisement data elements "A" and "B" as identical and unchanging (such *as* in Figures 1A and IB), this appears to be inconsistent with any "inherent" leading of changing positions.

Again, the rejection of the Office Action relies upon the belief that "the location of advertisements A and C *has to be changed".*   The language of the claims addresses the *positioning* of the "removable content *relative to* the source content", and not merely the content of advertisements, and thus the claim language requires that the position of the removable content relative to the source content be updated, and not merely that the content of the advertisement be updated.

The distinction between what Ebisawa shows and the requirements of the claims becomes even clearer when one looks to the disclosure of the Ebisawa, such as at col. 5, lines 35 through 50, where it states:

> In either case, commercial advertisements are kept "current", and since the amount of advertisement data is relatively small compared to the size of the game program itself, the amount of "download" time is small in the first discussed embodiment. Of course, the download time of advertisement selection code S in the second discussed embodiment is insubstantial.
> In accordance with the present invention, updated or "new" advertisement data is downloaded or a new advertisement selection-code is downloaded each time a game program is executed. However,

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> such data need not be downloaded every time the game program is executed, and instead, may be downloaded only on a new day or a new week (or month) on which the game program is executed.

As can be appreciated from this portion of the Ebisawa patent, it lacks any discussion of the updating of the *position* of the "advertisement data" in the game (in contrast to the updating of the *content* of the advertisement), and therefore it is submitted that Ebisawa would not lead one of ordinary skill in the art to "repositioning of the removable content relative to the source content" as required in claim 19, or the similar requirements in the other independent claims.

In summary, it is submitted that one of ordinary skill in the art, considering the disclosure of the Ebisawa patent, would be led to "advertisement data A, B, C, and D" that is uniformly located in the same *location*, even as the advertisement data displayed is changed from A to B to C to D, and so forth.   Considering Figures 1A and 1B of the Ebisawa . patent, it is clear that the position of the advertisement data *remains the .same* and that there is no updating of the position of the advertisement data. Similarly and consistently, Figures 2A and 2B show the substitution of "D" for "C" in the video game, but the position is clearly not changed or updated.

It is therefore submitted that not only does the Ebisawa not lead one of ordinary skill in the art to "the communication assembly is configured to cause the virtual product source to place the virtual product within the source content of the removable moving media at the position of the removable content disposed within the video frame of the source content", as the Ebisawa could only lead one of ordinary skill in the art toward a consistent, unchanging location for its advertising data that is not updated when the advertisement data is changed.   It is therefore also submitted that the allegedly obvious combination of Ebisawa and Margulis would not lead

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one of ordinary skill in the art to the combination of requirements of claims 33, 55, 56, and 66, and in particular the requirements set forth above.

As noted above, the rejections appear to rest upon the notion that merely changing *what* is displayed at a (same) location is actually changing *the* location.   In any event, claim 19 (as well as the other claims) requires the *repositioning*, or updating the position through repositioning, of the removable content with respect to the source content.

It is therefore submitted that the cited patents, and especially the allegedly obvious combination of Ebisawa and Margulis set forth in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claims 19, 33, 55, 56 and 66. Further, claims 22 through 25 and 57, which depend from claim 19, claims 34 through 39 and 62, which depend from claim 33, claim 58, which depends from claim 57, claim 59, which depends from claim 58, claim 60, which depends from claim 26, claim 61, which depends from claim 60, claim 63, which depends from claim 62, claim 64, which depends from claim 55 and claim 65, which depends from claim 64 also include the requirements discussed above and therefore are also submitted to be in condition for allowance.

Withdrawal of the §103(a) rejection of claims 19, 22 through 25, 33 through 39 and 55 through 66 is therefore respectfully requested.

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CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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